



Atty. Dkt. No. 029318-0978

***IN THE UNITED STATES PATENT AND TRADEMARK OFFICE***

Applicants: H. William BOSCH et al.  
Title: NOVEL GLIPIZIDE COMPOSITIONS  
Appl. No.: 10/701,064  
Filing Date: 11/05/2003  
Examiner: Susan T. TRAN  
Art Unit: 1615  
Confirmation No. 6295

**TERMINAL DISCLAIMER**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Your Petitioner, Elan Pharma International Limited, having its principal place of business at Treasury Building, Lower Grand Canal Street, Dublin 2, Ireland, represents that it is the owner of the entire right, title, and interest in and to U.S. Patent Application Serial No. **10/701,064**, filed **11/05/2003**, (which is a continuation of U.S. Patent Application No. 09/337, 675; filed 07/16/2003;) by virtue of an Assignment filed and recorded on **05/03/2004**, on Reel/Frame **015294/0735**, in the United States Patent and Trademark Office, a copy of which is attached hereto as APPENDIX A. Further, your Petitioner represents that it is the owner of U.S. Patent Application No. **10/619,539**, filed **07/16/2003**, by virtue of an Assignment filed and recorded on **08/18/2004**, on Reel/Frame **015072/0837**, in the United States Patent and Trademark Office, as recorded in the Patent Assignment Abstract of Title on the USPTO web site, a copy of which is attached hereto as APPENDIX B.

Your Petitioner, Elan Pharma International Limited, hereby disclaims the terminal part of the term of any patent granted on U.S. Patent Application 10/701,064 which would extend beyond the full statutory term, as shortened by any terminal disclaimer, of any

patent granted on U.S. Patent Application 10/619,539, and hereby agrees that any patent so granted on U.S. Patent Application 10/701,064 shall be enforceable only for and during such period that the legal title to any patent granted on U.S. Patent Application 10/619,539 shall be the same as the legal title to any patent granted on U.S. Patent Application 10/701,064, this agreement to run with any patent granted on U.S. Patent Application 10/701,064 and to be binding upon the grantee, its successors or assigns.

In making the above disclaimer, Petitioner does not disclaim any terminal part of any patent granted on U.S. Patent Application 10/701,064, prior to the full statutory term of any patent granted on U.S. Patent Application 10/619,539 as defined in 35 U.S.C. §§ 154-156 and 173, in the event that any patent granted on U.S. Patent Application 10/619,539 expires for failure to pay a maintenance fee, is held unenforceable or is found invalid in a final judgment by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR § 1.321(a), has all claims canceled by a reexamination certificate or as a result of an interference proceeding, or is otherwise not deemed to provide the rights conveyed by 35 USC § 154, prior to the full statutory term of any patent granted on U.S. Patent Application 10/619,539 as defined in 35 USC §§ 154-156 and 173, except for the separation of legal title stated above. Further, Petitioner does not disclaim any terminal part of a patent granted on U.S. Patent Application 10/701,064 that would extend beyond the present termination of any patent granted on U.S. Patent Application 10/619,539, in the event that such present term is extended by virtue of compliance with the conditions for term extension of any present or future patent term extension provisions of the patent law, including but not limited to 35 U.S.C. §§ 155, 155A or 156, and without waiving Petitioner's right to extend the term of a patent granted on U.S. Patent Application 10/701,064 to the extent provided by law.

The undersigned, being the Attorney of Record for U.S. Patent Application 10/701,064, and duly authorized to act on behalf of Petitioner, certifies that she has reviewed the Assignments attached as APPENDICES A and B, and to the best of her knowledge and belief, legal title to U.S. Patent Application 10/701,064 and any patent granted on U.S. Patent Application 10/619,539 rests with Petitioners, Elan Pharma International Limited. The

undersigned declares that all statements made herein of her own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-identified application or any patent issuing therefrom.

Respectfully submitted,

Date July 6, 2007

By Michele M. Simkin

FOLEY & LARDNER LLP  
Customer Number: 31049  
Telephone: (202) 672-5538  
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Michele M. Simkin  
Attorney for Applicants  
Registration No. 34,717

# **APPENDIX A**



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

OCTOBER 27, 2004

PTAS



\*102738864A\*

FOLEY & LARDNER  
MICHELE M. SIMKIN  
WASHINGTON HABROUR  
3000 K STREET, N.W., SUITE 500  
WASHINGTON, D.C. 20007-5143

UNITED STATES PATENT AND TRADEMARK OFFICE  
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

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PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 05/03/2004

REEL/FRAME: 015294/0735  
NUMBER OF PAGES: 3

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

BOSCH, H. WILLIAM

DOC DATE: 11/12/2003

ASSIGNOR:

RYDE, NIELS P.

DOC DATE: 11/14/2003

ASSIGNEE:

ELAN PHARMA INTERNATIONAL LIMITED  
WIL HOUSE, SHANNON BUSINESS PARK  
SHANNON, CO. CLARE, IRELAND

SERIAL NUMBER: 10701064

FILING DATE: 11/05/2003

PATENT NUMBER:

ISSUE DATE:

TITLE: NOVEL GLIPIZIDE COMPOSITIONS

015294/0735 PAGE 2

MAURICE CARTER, PARALEGAL  
ASSIGNMENT DIVISION  
OFFICE OF PUBLIC RECORDS

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05-06-2004



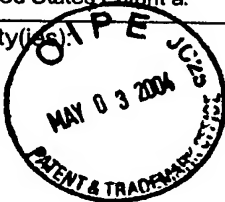
102738864

EET

To the Director of the United States Patent a.

Patent Office: Please record the attached original documents or copies thereof.

1. Name of conveying party(ies):

H. William Bosch  
Niels P. Ryde

S.3.04

2. Name and address of receiving party(ies):

Elan Pharma International Limited  
WIL House, Shannon Business Park  
Shannon, Co. Clare  
Ireland

Additional conveying party(ies)

NO

3. Nature of conveyance:

ASSIGNMENT

Execution Date:

November 12 and 14, 2003

Additional name(s) &amp; address(es) attached?

NO

4. Application number(s) or patent number(s):

If this is being filed together with a new application, the execution date of the application is:

A. Patent Application Number(s):

10/701,064

B. Patent Number(s):

Additional numbers attached? NO

5. Name and address of party to whom correspondence concerning document should be mailed:

Michele M. Simkin  
FOLEY & LARDNER LLP  
Washington Harbour  
3000 K Street, N.W., Suite 500  
Washington, D.C. 20007-5143

6. Total number of applications/patents involved:

1

7. Total fee (37 C.F.R. § 3.41):

\$40.00

☒ Check Enclosed

Charge to deposit account

8. Deposit account number: 19-0741

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9. Statement and signature:

*To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document. The Commissioner is hereby authorized to charge any additional recordation fees which may be required in this matter to the above-identified deposit account.*

Michele M. Simkin

5/3/04

Name of person signing

Signature

Date

Total number of pages including cover sheet, attachments, and document: 3

05/05/2004 MGETACHE 00000068 10701064

01 FC:8021

40.00 DP

002.1190871.1

## ASSIGNMENT - WORLDWIDE

For good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, each undersigned inventor has sold and assigned, and by these presents hereby sells and assigns, unto

*name and  
address of  
assignee(s)*

ELAN PHARMA INTERNATIONAL, LTD.  
WIL House, Shannon Business Park, Shannon, Co. Clare, Ireland

its successors and assigns, the entire right, title and interest, so far as concerns the United States and the Territories and Possessions thereof and all foreign countries in and to the invention in

*title of  
invention* NOVEL GLIPIZIDE COMPOSITIONS

as set forth in this United States Patent Application

*check one*

☐ executed concurrently herewith

☐ executed on

☒ Serial No. 10/701,064 Filed 11/05/2003

said application for United States Letters Patent, including all divisional, renewal, substitute, continuation and Convention applications based in whole or in part upon said inventions or upon said applications, and any and all Letters Patent and reissues and extensions of Letters Patent granted for said inventions or upon said applications and every priority right that is or may be predicated upon or arise from said inventions, said applications, and said Letters Patent; said Assignee being hereby authorized to file patent applications in any or all countries on any or all said inventions in the name of the undersigned or in the name of said Assignee or otherwise as said Assignee may deem advisable, under the International Convention or otherwise; the Commissioner of Patents and Trademarks of the United States of America being hereby authorized to issue or transfer all said Letters Patent to said Assignee in accordance herewith; this assignment being under covenant, not only that full power to make the same is had by the undersigned, but also that such assigned right is not encumbered by any grant, license, or other right theretofore given, and that the undersigned will do all acts reasonably serving to ensure that the said inventions, patent applications and Letters Patent shall be held and enjoyed by said Assignee as fully and entirely as the same could have been held and enjoyed by the undersigned if this assignment had not been made, and particularly to execute and deliver to said Assignee all lawful documents including petitions, specifications, oaths, assignments, invention disclaimers, and lawful affidavits in form and substance which may be requested by said Assignee, to furnish said Assignee with all facts relating to said inventions or



the history thereof and any and all documents, photographs, models, samples or other physical exhibits which may be of said inventions, and to testify in any proceedings relating to said inventions, patent applications and Letters Patent.

The undersigned hereby grant the firm of FOLEY & LARDNER the power to insert in this Assignment any further identification which may be necessary or desirable to comply with the rules of the U.S. Patent and Trademark Office for recordation of this Assignment.

NAMES AND SIGNATURES OF INVENTORS		
Name: H. William Bosch	Signature: <i>H. William Bosch</i>	Date: <i>Nov. 12, 2003</i>
Name: Niels P. Ryde	Signature: <i>Niels P. Ryde</i>	Date: <i>Nov. 14, 2003</i>
Name:	Signature:	Date:
NAMES AND SIGNATURES OF WITNESSES		
Name: <i>CAROL WRAY</i>	Signature: <i>[Signature]</i>	Date: <i>Nov 12, 2003</i>
Name: <i>CAROL WRAY</i>	Signature: <i>[Signature]</i>	Date: <i>Nov 14, 2003</i>

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IPT-407:4/90(1)(modified)

## **APPENDIX B**



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## Assignments on the Web &gt; Patent Query

## Patent Assignment Abstract of Title

**NOTE: Results display only for issued patents and published applications.  
For pending or abandoned applications please consult USPTO staff.**

## Total Assignments: 1

Patent #: NONE

Issue Dt:

Application #: 10619539 Filing Dt: 07/16/2003

Publication #: US20040258757 Pub Dt: 12/23/2004

Inventors: H. William Bosch, Matthew R. Hilborn, Douglas C. Hovey, Laura J. Kline, Robert W. Lee et al

Title: Liquid dosage compositions of stable nanoparticulate active agents

## Assignment: 1

Reel/Frame: 015072/0837

Recorded: 08/18/2004

Pages: 9

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

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Exec Dt: 07/23/2003

KLINE, LAURA J.

Exec Dt: 07/23/2003

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Exec Dt: 07/29/2003

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Exec Dt: 07/23/2003

RYDE, TUULA A.

Exec Dt: 07/23/2003

XU, SHUQIAN

Exec Dt: 08/13/2003

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